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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/326,285	06/07/99	SHEN	J BB-1137

HM12/0130  
E I DU PONT DE NEMOURS AND COMPANY  
LYNNE M CHRISTENBURY  
LEGAL PATENTS  
WILMINGTON DE 19898

EXAMINER

BUI, P

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 01/30/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/326,285

Applicant(s)  
Shen

Examiner  
Phuong Bui

Group Art Unit  
1638



- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a). P. 129/01

## Disposition of Claims

- ☒ Claim(s) 1-171 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claims 1-171 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1 and 2, drawn to a corn oleosin promoter, classified in class 536, subclass 24.1.
  - II. Claims 3-4, drawn to an isolated nucleic acid molecule encoding corn delta-9 or 12 desaturase, classified in class 536, subclass 23.2.
  - III. Claims 5-22, drawn to a chimeric gene, classified in class 536, subclass 23.6.
  - IV. Claims 23-78 and 169, drawn to corn plants, plant parts, grain or seed, classified in class 800, subclass 281.
  - V. Claims 79-96, drawn to extracted oil, classified in class 554, subclass 9.
  - VI. Claims 97-114 and 170, drawn to animal feed derived from corn grain, classified in class 426, subclass 622.
  - VII. Claims 115-132, drawn to the use of oil in food, animal feed, cooking, or industrial applications, classified in class 426, subclass 531.
  - VIII. Claims 133-150, drawn to products made from oil, classified in class 554, subclass 169.
  - IX. Claims 151-168 and 171, drawn to a method of improving carcass quality, classified in class 426, subclass 2.

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For each of inventions I-IX above, restriction to one of the following is also required under 35 USC 121. However, Applicant may elect either: 1) one of inventions (a)-(m) or one of inventions (i)-(xii), to be examined as a subcombination; or 2) one of inventions (a)-(m) and one of inventions (i)-(xii), to be examined as a combination.

(a). SEQ ID No: 19.

(b). SEQ ID No: 38.

(c). SEQ ID No: 39.

(d). SEQ ID No: 40.

(e). SEQ ID No: 41.

(f). SEQ ID No: 42.

(g). SEQ ID No: 43.

(h). SEQ ID No: 44.

(i). SEQ ID No: 45.

(j). SEQ ID No: 46.

(k). SEQ ID No: 47.

(l). SEQ ID No: 48.

(m). SEQ ID No: 49.

For each of inventions II-IX above, restriction to one of the following is also required under 35 USC 121 in addition to electing one of inventions II-IX, one of inventions (a)-(m) above, and one of inventions (i)-(xii) below.

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- (i). SEQ ID No: 8.
- (ii). The reverse complement of SEQ ID No: 8.
- (iii). SEQ ID No: 10.
- (iv). The reverse complement of SEQ ID No: 10.
- (v). SEQ ID No: 2.
- (vi). The reverse complement of SEQ ID No: 2.
- (vii). SEQ ID No: 1.
- (viii). The reverse complement of SEQ ID No: 1.
- (ix). SEQ ID No: 58.
- (x). The reverse complement of SEQ ID No: 58.
- (xi). SEQ ID No: 59.
- (xii). The reverse complement of SEQ ID No: 59.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I, II, (a)-(m) and (i)-(xii) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions, represent structurally polynucleotides. Therefore, where structural identity is required, such as for hybridization or expression or for functional use as a promoter, the different sequences have different effects.

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3. Invention IX and inventions I-VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are structurally different by virtue of the hydrogenation, fractionation, interesterification or hydrolysis of the oil. This processing of the oil changes the product in such a way that, in use, it will function differently with a different effect. Accordingly, invention IX is unrelated to the other recited inventions.

4. Inventions III and (I and II) are related as combination and subcombinations. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not rely solely upon the particulars of either of the subcombinations as claimed for patentability, and (2) that each subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not rely solely upon the particulars of either of the subcombinations as claimed because each subcombination is presented as a separately claimed invention. The subcombinations have separate utilities from each other. For example, the promoter can be used for promoting expression of any heterologous sequence for expression in plants. The enzyme genes can be used in a bacterial host for expression of the enzyme in vitro.

5. Inventions IV and (III, V and VI) are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not rely solely upon the particulars of either of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP

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§ 806.05(c)). In the instant case, the combination as claimed does not rely solely upon the particulars of either of the subcombinations for patentability as claimed because each subcombination is presented as a separately claimed invention. The subcombinations have separate utilities from each other. For example, the oil may be used for cooking. The animal feed may be used directly as a dietary component. The chimeric gene may be used in a bacterial host for expression of the enzyme(s) in vitro.

6. Inventions V and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP

§ 806.05(h)). In the instant case, the product as claimed can be used in another and materially different method such as one in which the oil is used as an ingredient in a pharmaceutical preparation for topical use.

7. Inventions VI and IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP

§ 806.05(h)). In the instant case, the product as claimed can be used in another and materially different process such as one in which the animal feed is used to improve the milk or egg production of animals rather than the quality of the animal carcass.

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8. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and the literature and sequence searches required for each of the Groups are not required for another of the Groups, restriction for examination purposes as indicated is proper.

9. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

11. Papers relating to this application may be submitted to Technology Sector 1 by facsimile transmission. Papers should be faxed to Crystal Mall 1, Art Unit 1638, using fax number (703) 308-4242. All Technology Sector 1 fax machines are available to receive transmissions 24 hrs/day, 7 days/wk. Please note that the faxing of such papers must conform with the Notice published in the Official Gazette, 1096 OG 30, (November 15, 1989).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong Bui whose telephone number is (703) 305-1996. The Examiner can normally be reached Monday-Friday from 6:30 AM - 4:00 PM.



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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Paula Hutzell, can be reached at (703) 308-4310.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0196.

Phuong Bui  
Primary Examiner  
Group Art Unit 1638  
January 29, 2001

  
**PHUONG T. BUI**  
**PRIMARY EXAMINER**